

## REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, now rejected all claims 1-27 under 35 U.S.C 112, first paragraph. In response, claims 1 and 27 have been amended to delete the term "simultaneously". Applicant submits that no new matter has been added.

### **35 U.S.C 112**

Claims 1-27 stand rejected under U.S.C 112, first paragraph, as failing to comply with the written description requirement. In stating the rejection, the Office Action alleged that the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action noted alleged that the aspect in claims 1 and 27 of "simultaneously dissolving one or more kinds of bioresorbable polymers and a low molecular weight oligomer in an organic solvent to form a bioresorbable polymer solution" appears to lack support in the disclosure as filed.

In response to the rejection, applicant amended independent claims 1 and 27 to delete the term "simultaneously". This amendment obviates the 112 rejections.

### **35 U.S.C. 103(a)**

Claims 1-27 apparently remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ma (US 6,673,285), as the Office Action states that our previous arguments are not persuasive, but are considered to be moot. The undersigned doesn't

understand how the 112 rejection renders a prior art based rejection moot, and therefore sets for the following additional comments.

**Ma fails to teach or suggest a coagulating step in porous material preparation.**

Claims 1 and 27 recite “dissolving one or more kinds of bioresorbable polymers and a low molecular weight oligomer in an organic solvent to form a bioresorbable polymer solution, and a coagulating step: exposing the **bioresorbable polymer solution** to a coagulant to form the porous material”. Accordingly, the claims require the bioresorbable polymer solution being exposed to a coagulant to form the porous material. As set forth in the specification at page 12 Example 1, PCL (bioresorbable polymer) and PEG (oligomer) were added to THF (organic solvent) to form a PCL solution containing PEG oligomer (bioresorbable polymer solution). The solution was then coated onto the surface of a plate-shaped mold. The plate-shaped mold coated with PCL solution was then placed in a coagulant. Thus, the PCL solution was coagulated to form a porous PCL material.

The previous Office Action allege that it would have been obvious to one of ordinary skill in the art to cause coagulation of the polymeric material in order to cause the material to set in final form. Even if “hexane” can be interpreted as coagulant of the invention, it fails to expose a bioresorbable polymer **“solution”** to hexane. The Examiner’s attention is called to column 10, lines 16-33 of Ma et al, which states:

*A chosen polymer (biodegradable polymer) was dissolved in pyridine (organic solvent) to prepare a solution...  
0.4ml of the polymer solution were cast onto the paraffin sphere (oligomer)...*

*The dried paraffin/polymer discs were removed from the TEFLON mold...  
The discs were immersed in 200ml hexane to dissolve the paraffin...*

Clearly, the porous material is formed by exposing the paraffin of the solid (dried) paraffin/polymer disc (not a polymer solution) to hexane. In fact, Ma never teaches or suggests a coagulating step. Thus, the cited reference fails to disclose exposing the biodegradable polymer solution to coagulant.

Accordingly, the distinctions over Ma are, in fact, not rendered moot by the 112 rejections, but are still quite relevant.

Accordingly, applicant respectfully submits that the cited art fails to disclose all the limitations of claims 1 and 27. For at least these reasons, claims 1 and 27 are allowable over the cited reference. Insofar as claims 2-26 depend from claim 1, these claims are also allowable.

### **CONCLUSION**

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:



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